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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,867	02/27/2004	George A. Heavner	CEN0320CIP1	1167

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EXAMINER

SPECTOR, LORRAINE

ART UNIT PAPER NUMBER

1647

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/789,867

Applicant(s)

HEAVNER ET AL.

Examiner

Lorraine Spector, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

### **DETAILED ACTION**

Claim 29 is indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim. Accordingly, the claim is withdrawn from prosecution and cannot be included in the restriction requirement set forth below, as it cannot be determined what the claim is drawn to.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, 7 in part, 8-15 and 20-24 as they are drawn to nucleic acids protein and methods of making protein , classified in class 435, subclass 69.1.
- II. Claims 6 and 20-24 as they are drawn to to antibodies, classified in class 530, subclass 387.9.
- III. Claim 7 in part, as it is drawn to nucleic acids encoding antibodies, classified in class 536, subclass 23.5 for example.
- IV. Claims 16-19 as they are drawn to diagnostic methods that use nucleic acids, classified in class 435, subclass 6.
- V. Claims 16-19 as they are drawn to diagnostic methods that use proteins, classified in class 435, subclass 7.1.
- VI. Claims 16-19 as they are drawn to diagnostic methods that use nucleic acids, classified in class 435, subclass 7.1.
- VII. Claims 16-19 as they are drawn to methods of treatment that use nucleic acids, classified in class 424, subclass 93.21.

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VIII. Claims 16-19 as they are drawn to methods of treatment that use proteins, classified in class 424, subclass 130.1.

IX. Claims 16-19 as they are drawn to methods of treatment that use nucleic acids, classified in class 514, subclass 2.

The inventions are distinct, each from the other because:

The polypeptide of Invention I is related to the antibody of Invention II by virtue of being the cognate antigen, necessary for the production of the antibodies. Although the protein and antibody are related due to the necessary steric complementarity of the two, they are distinct inventions because they are physically and functionally distinct chemical entities, and because the protein can be used another and materially different process from the use for production of the antibody, such as in a pharmaceutical composition in its own right, or in assays for the identification of agonists or antagonists of the protein. Further, the searches for the two inventions are not coextensive and would be burdensome to the Examiner.

The nucleic acid of Invention I is distinct from and unrelated to the antibody of Invention II because they are physically and functionally distinct chemical entities which share neither structure nor function. Also, neither is required for the manufacture of the other. The method of Invention I is distinct from and unrelated to the antibody of Invention II because the antibody may be neither made by nor used in the method. Further, the searches for the two inventions are not coextensive and would be burdensome to the Examiner.

The nucleic acids of Invention I are separate and distinct from the nucleic acids of Invention III because they share no common structure that is related to a disclosed common use; as the antibody and protein are separate and distinct, so are the nucleic acids encoding them.

The nucleic acids of Invention III are related to the antibody of Invention II by virtue of encoding same. The DNA molecule has utility for the recombinant production of the protein in a host cell. Although the DNA molecules and proteins are related since the DNA encodes the

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specifically claimed antibody, they are distinct inventions because they are physically and functionally distinct chemical entities, and the protein (antibody) product can be made by another and materially different process, such as by synthetic peptide synthesis or purification from the natural source. Further, the DNA may be used for processes other than the production of the protein, such as nucleic acid hybridization assay.

Invention III is separate and distinct from each of the methods of Inventions IV-IX, wherein the product is neither made by nor used in the methods.

Inventions I-II are related to inventions IV-V and VI, respectively, and to inventions VII-VII and IX respectively as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products as claimed may be used in either of the two patentably distinct processes (see below).

Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different methods, restriction is deemed to be proper because these methods appear to constitute patentably distinct inventions for the following reasons: Groups IV-VI are directed to methods that are distinct both physically and functionally from those of groups VII-IX, respectively, and are not required one for the other. It is not clear that the same condition can be diagnosed by assaying for the presence of a nucleic acid, protein or antibody and be treated by the administration of the same chemical entity. Therefore, a search and examination of both methods of diagnosis and methods of treatment in one patent application would result in an undue burden, since the searches for the methods are not co-extensive, the classification is different, and the subject matter is divergent.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

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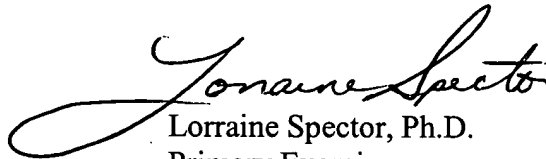
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Lorraine M. Spector. Dr. Spector can normally be reached Monday through Friday, 9:00 A.M. to 3:00 P.M. at telephone number 571-272-0893.

If attempts to reach the Examiner by telephone are unsuccessful, please contact the Examiner's supervisor, Ms. Brenda Brumback, at telephone number 571-272-0961.

Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Official papers filed by fax should be directed to **571-273-8300**. Faxed draft or informal communications with the examiner should be directed to **571-273-0893**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Lorraine Spector, Ph.D.  
Primary Examiner